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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,450	11/25/2003	John J. Breen	16356.827 (DC-05388)	7118
27683 7590 04/12/2007 HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			EXAMINER ONEILL, KARIE AMBER	
			ART UNIT 1745	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS		MAIL DATE 04/12/2007	DELIVERY MODE PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/721,450	BREEN ET AL.	
	Examiner	Art Unit	
	Karie O'Neill	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2007.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 29-54 is/are pending in the application.
- 4a) Of the above claim(s) 29-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 26, 2007, has been entered.
2. Claims 1-28 have been cancelled. Claims 29-38 have been withdrawn from consideration. Claims 39-54 have been added.

### ***Election/Restrictions***

3. This application contains claims directed to the following patentably distinct species:

**Species I:** Claims 39-44, drawn to a battery assembly comprising: a plurality of battery assemblies that are operable to be mechanically and electrically connected together to form a battery assembly, the plurality of battery subassemblies designed to be shipped such that an additional shipping fee that would be incurred due to a battery characteristic that is not the total weight of the battery assembly is not incurred.

**Species II:** Claims 45-50, drawn to a battery powered device comprising, a chassis; a battery bay defined by the chassis; and a battery assembly comprising: a plurality of battery assemblies that are operable to be mechanically

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and electrically connected together to form a battery assembly, the plurality of battery subassemblies designed to be shipped such that an additional shipping fee that would be incurred due to a chemical mass in the battery is not incurred.

**Species III:** Claims 51-54, drawn to a battery powered device comprising, a chassis; a battery bay defined by the chassis; and a battery assembly comprising: a plurality of battery assemblies that are operable to be mechanically and electrically connected together to form a battery assembly, the plurality of battery subassemblies designed to be shipped such that an additional shipping fee that would be incurred due to a watt-hour rating of the battery assembly is not incurred.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, none of the claims are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

4. During a telephone conversation with James Bell on March 30, 2007, a provisional election was made without traverse to prosecute the invention of Species III, claims 51-54. Affirmation of this election must be made by applicant in replying to this Office action. Claims 39-50 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osaka (US 5,628,054) and in view of Rasmussen et al. (US 2003/0167244 A1), as evidenced by Wehmeyer.

With regard to Claims 51-52, Osaka discloses a battery powered device or portable radio apparatus, comprising a chassis or main unit (12) and a battery pack (14) with a battery bay attached to the chassis; and a battery assembly located in the battery bay and operable to provide power to the portable radio apparatus, the battery assembly comprising a plurality of battery subassemblies that are operable to be mechanically and electrically connected together to form the battery assembly. The battery pack contains a nickel metal hydride battery (14a) and a lithium ion battery (14b) which are connected electrically, as can be seen in Figures 1 and 2, and mechanically connected through the cable that electrically connects the two battery subassemblies together. In Figure 2, the nickel metal hydride battery (14a) comprises a first subassembly to subassembly electrical connector, a first subassembly to subassembly mechanical connector provided through the cable which connects the subassemblies to one another, and a device power connector or power output terminal to supply power to the radio apparatus (15a). Figure 2 also discloses a lithium ion battery (14b) with a second battery subassembly electrically and mechanically connected to the first battery subassembly (14a), the second battery subassembly comprising a second subassembly to subassembly electrical connector electrically connected to the first subassembly of the first battery and a second subassembly to subassembly mechanical connector mechanically connected to the first subassembly of the first battery. Osaka does not disclose wherein the battery subassemblies are designed to be shipped such that an additional shipping fee that would be incurred due to a watt-hour rating of the battery assembly is not incurred.

Rasmussen et al. disclose a method of optimizing weight based delivery fees. The contents of the components to be shipped may be modified to reduce the overall weight of the package to be shipped when such a weight reduction results in the package weight being within a lower weight category resulting in a lower delivery cost (paragraph 0010). While Rasmussen et al. do not disclose the components to be shipped as battery subassemblies, it is disclosed that once the individual weights of the components of the parcel have been determined, a total weight of the parcel is calculated and a comparison between the total weight and the incremental weight breakpoints is made. If the delivery fee of the individual component is less than that of the total weight of the components it would be evident that one would ship the individual components separately. Therefore, it would have been obvious to one of ordinary skill in the art to ship each of the batteries separately so as not to damage the cells in transit, and in order to keep the shipping costs down so as to maintain a product that is cost effective and within a price range for the consumer to purchase both of the battery subassemblies. Consequently, they are to be used together to power the battery powered device, as disclosed by Osaka.

Wehmeyer discloses the energy density of several different battery types, energy density including the watt-hour rating of the battery based on the weight of the battery. The energy density of each individual battery teaches that the watt-hour rating is directly correlated with the weight, in kilograms or liters, of the battery. Rasmussen et al. teach the shipping costs incurred are based upon the individual and/or total weight of the items or batteries to be shipped. Wehmeyer links the weight and watt-hour rating to one

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another through the disclosure of the energy density. If the battery is to provide a certain or given energy density, the watt-hour rating of the battery must adjust to meet these demands. When the watt-hour rating adjusts, meaning it increases or decreases the energy density the battery is able to provide, the weight of the battery also varies accordingly, because the watt-hour rating is shown in Wehmeyer as a function of weight.

With regard to Claims 53 and 54, Osaka discloses in Figure 4, the battery powered device or portable radio apparatus comprises an information handling system which comprises a processor or processing section (12b) which receives and transmits signals located in the chassis or main unit (12). Although a memory is not disclosed by Osaka, it is known that with a portable radio apparatus a memory would be present so as to remember the frequency that the radio was last programmed or tuned to before and after turning on and off the apparatus.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karie O'Neill whose telephone number is (571) 272-8614. The examiner can normally be reached on Monday through Friday from 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Karie O'Neill  
Examiner  
Art Unit 1745

KAO



DAH-WEIYUAN  
PRIMARY EXAMINER